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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,415	10/16/2001	Kevin Cooper	ETH1600	5232

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AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978415

Applicant(s)

Cooper

Examiner

Short

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on May 28, 2003
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 21-25 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 21-25 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kaplan '624. The rejection is applied as in the previous Office Action. Applicant argues that the reference fails to disclose a two phase system that provides a visual cue when heated to a temperature greater than the melting temperature of the dispersed phase to about 65° C and that heating the article to 85° C to 100° C eliminates the crystalline structure in the article and thus, prevents any visual cue upon heating. The articles taught by Kaplan are prepared from the same polymers in the same amounts and in essentially the same manner as the claimed articles with the exception of shaping at a temperature effective to provide a visual cue up to a maximum temperature of about 65° C. The glycolide and/or lactide polymer is melt blended with polycaprolactone and articles are formed by extrusion or injection molding under conditions similar to those disclosed by applicant. Compare Kaplan at col. 5, lines 24-40 and col. 5, line 55 - col. 6, line 7 with the specification at page 8, lines 12-28 and page 9, line 29 - page 10, line 5. It is not clear how further shaping the article at a temperature effective to provide a visual cue to a maximum temperature of about 65° C distinguishes the claimed article over the articles of the reference. The optional heating at 85° C to 100° C taught by Kaplan for

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the purpose of annealing the articles would not eliminate the crystalline structure of the shaped articles as the crystalline structure would reform upon cooling.

Claims 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP '044 (Cooper). The rejection is applied as in the previous Office Action. Applicant argues that the reference fails to disclose a two phase system that provides a visual cue when heated to a temperature greater than the melting temperature of the dispersed phase to about 65° C and that heating the article to 80° C to 100° C eliminates the crystalline structure in the article and thus, prevents any visual cue upon heating. The articles taught by EP '044 are prepared from the same polymers in the same amounts and in essentially the same manner as the claimed articles with the exception of shaping at a temperature effective to provide a visual cue up to a maximum temperature of about 65° C. The glycolide and/or lactide polymer is melt blended with polycaprolactone and articles are formed by extrusion or injection molding under conditions similar to those disclosed by applicant. Compare EP '004 at col. 5, lines 2-17 and col. 6, lines 10-18 with the specification at page 8, lines 12-28 and page 9, line 29 - page 10, line 5. As the crystalline structure of the shaped articles would reform upon cooling, it is not clear how further shaping the article at a temperature effective to provide a visual cue to a maximum temperature of about 65° C distinguishes the claimed article over the articles of the reference where further shaping is carried out by heating at a temperature of 80° C to 100° C.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

P. Short

July 30, 2003

Phone (703) 308-2395

Fax (703) 872-9311

PATRICIA A. SHORT
PRIMARY EXAMINER

Patricia A. Short